

REMARKS

Claims 1, 3-9, and 12-19 are all the claims pending in the application. Claim 2 has been canceled without prejudice or disclaimer and claims 14-19 have been newly added.

Claim Objections

The Examiner objects to claim 8 because of an informality. Applicants have amended claim 8 in a manner believed to overcome the objection.

Claim Rejections

A) Yamazaki et al.

Claims 1, 4, 7, 8 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yamazaki et al. (U.S. 2001/0036376). Applicants respectfully traverse this rejection.

Yamazaki fails to disclose every element of the claimed invention. For example, Yamazaki lacks a conductive agent as set forth in claim 1. The conductive agent reduces the electric resistance of the outer layer and therefore improves development characteristics (*see*, for example, paragraph [0019] of the specification) The Examiner asserts that carbon in the outer resin layer of Yamazaki constitutes the claimed conductive agent. The Examiner particularly cites paragraph [0063] of Yamazaki as teaching that the outer resin layer contains carbon and paragraphs [0037] and [0084] for the assertion that carbon is a conductive agent. However, while paragraphs [0037] and [0084] discuss electroconductive carbon as a conductive agent, these paragraphs do not relate to the Yamazaki outer resin layer. Paragraphs [0037] and [0084] state that an electroconductive carbon may be used as a conductive agent, but do not indicate that any carbon generally would be a conductive agent. Paragraph [0063], which does relate to the

Yamazaki outer resin layer, only recites a carbon generally and not an electroconductive carbon. Since the carbon for the alleged resin outer layer is not specified as an electroconductive carbon, there is no indication that it could constitute the claimed conductive agent.

Claim 1 also recites that the mean particle diameter of the fine particles is in a range of 1 to 50 μ m. Having a mean particle diameter in the claimed range assists in obtaining good image quality and durability. The Examiner asserts that Yamazaki would inherently include fine particles. However, even if, for the sake of argument alone, Yamazaki did have fine particles, the fine particles would not necessarily have the mean particle diameter range as claimed. Accordingly, Yamazaki would not benefit from the image quality and durability from a device with a mean particle diameter as claimed. In view of the above, claim 1 is allowable over Yamazaki because Yamazaki lacks a conductive agent and mean particle diameter as claimed. Claims 4 and 13 depend from claim 1 and are therefore allowable at least because of their dependency.

Claim 7 also recites that the mean particle diameter of the fine particles is in a range of 1 to 50 μ m. Accordingly, claim 7 is allowable over Yamazaki at least because Yamazaki lacks this feature. Claim 8 depends from claim 7 and is therefore allowable at least because of its dependency.

B) Achiha et al.

Claim 6 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Achiha et al. (JP 2002-310136). Applicants respectfully traverse this rejection.

Claim 6 recites that the mean particle diameter of the fine particles is in a range of 1 to 50 μ m. The Examiner asserts that Achiha would inherently have fine particles. However, even if Achiha device did have fine particles, the Achiha device would not necessarily have fine particles with the claimed mean particle diameter. Accordingly, claim 6 is allowable over Achiha.

C) Hayashi et al.

Claims 1, 4, 7, 12 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hayashi et al. (U.S. 6,096,395). Applicants respectfully traverse this rejection.

As discussed above, claims 1 and 7 recite a particular mean particle diameter of fine particles. Similarly to the above references, the Examiner asserts that Hayashi would inherently have fine particles. However, as with the above references, even if the Hayashi device did have fine particles, the Hayashi device would not necessarily have fine particles with the claimed mean particle diameter. Accordingly, claims 1 and 7 are allowable over Hayashi. Claims 4, 12 and 13 depend from claim 1 and are therefore allowable at least because of their dependency.

D) Nakada et al.

Claims 1-5, 7, 8 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by newly cited Nakada et al. (U.S. 6,390,961). Applicants respectfully traverse this rejection.

Applicants submit that the claimed invention is allowable over Nakada at least because Nakada fails to disclose each and every element as claimed. With regard to claim 1, the Examiner asserts that Nakada discloses a developing roller including a shaft 1, an elastic layer (base rubber layer 2) and a resin outer layer (cladding layer 3), as shown in Figs. 1A and 1B.

Nakada also discloses a charge controlling agent dispersed in the cladding layer 3 with an average particle diameter of 0.1 to 30 μ m. The charge controlling agent is included in an amount of 5 to 20 parts by weight per 100 parts by weight of the synthetic resin in the cladding layer 3 (*see* column 7, lines 1-8). Thus, the Examiner asserts that the controlling agent constitutes both the claimed fine particles and the claimed conductive agent.

However, the Nakada controlling agent is a dielectric material (*see*, column 8, lines 17-25). A dielectric material acts oppositely of a conductive agent. That is, a conductive agent is conductive, while a dielectric material is generally non-conductive. Therefore, the Nakada controlling agent is not the same as the claimed conductive agent. Accordingly Nakada fails to teach a conductive agent as set forth in claim 1. Claims 2-5 and 13 depend from claim 1 and are therefore allowable over Nakada at least because of their dependency.

Applicants also submit that claim 7 is allowable over Nakada at least because Nakada fails to teach fine particles as claimed. As discussed above, the Examiner asserts that the Nakada controlling agent constitutes fine particles. However, Nakada does not teach, and the Examiner does not assert that Nakada teaches, that the controlling agent is made of a rubber or a synthetic resin as recited in claim 7. It is noted that the Examiner does assert that Nakada has an outer layer made of melamine resin (*see* column 3, lines 25-30) and that the melamine resin is inherently made of fine particles causing a surface roughness. However, even if the Nakada outer layer did have fine particles, there is no suggestion that the fine particles would have the claimed mean particle diameter of claim 7. Accordingly, claim 7 is allowable over Nakada at

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/730,248
Atty. Docket No. Q78868

least because Nakada lacks fine particles and the mean particle diameter as claimed. Claim 8 depends from claim 7 and is therefore allowable at least because of its dependency.

E) Yamazaki in view of Eguchi et al.

Claims 1, 9 and 13 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Yamazaki in view of Eguchi et al. (JP 63-307465). Applicants respectfully traverse this rejection.

Claims 9 and 13 depend from claim 1. As discussed above, claim 1 is allowable over Yamazaki at least because Yamazaki lacks a conductive agent and a mean particle diameter as claimed. Eguchi fails to correct these deficiencies of claim 1. Accordingly, claims 9 and 13, which depend from claim 1, are allowable over the combined teachings and suggestions of Yamazaki and Eguchi.

New Claims

Applicants have added new claims 14-19 in order to provide a more varied scope of protection. Claims 14-16 depend from claim 6 and claims 17-19 depend from claim 7. Therefore, claims 14-19 are allowable at least because of their respective dependencies.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/730,248
Atty. Docket No. Q78868

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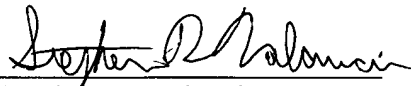
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